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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,204	12/04/2001	Hiromichi Inagaki	Komatsu Case 260	8211

7590 06/27/2003

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/009,204

Applicant(s)

INAGAKI ET AL.

Examiner

Victor S Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1204.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 2-5, the structural relations between the layers are vague, indefinite and confusing. The Examiner suggests to re-write the claim in "comprising" format so as to clearly claim that the "non-adhesive protective material layer" is an outer layer, with the adhesive layer as the intermediate layer. Also, at line 3, the phrase "partially covered" is vague, indefinite and confusing; for example, the "non-adhesive protective material layer" could all be "partially" placed just at the right side of the adhesive sheet and renders the right side completely non-adhesive, and the left side fully adhesive. Further, at line 6, the Examiner suggests to insert --the total volume of the-- before "spaces". Lastly, at line 8, the term "regulated" is vague and indefinite, i.e., it is not clear to the Examiner as to what property being "regulated".

In claim 2, line 2, the phrase "face side" is vague, indefinite and confusing, i.e., it is not clear as to which layer the "face side" belongs to. Clarification is requested. For the purpose of this Office action, it is presumed to be the surface of the substrate on the side next to the adhesive layer.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 49-30430 (English Abstract).

JP '430 teaches an adhesive sheet (or fastener) comprising a non-adhesive layer such as fine particles, fine fibers or fine mesh on an adhesive layer, and a support layer. Further, JP '430 teaches that the adhesion and releasing can be repeated (Abstract). Although JP '430 does not expressly teach the thickness of the non-adhesive layer, it is noted that JP '430 teaches essentially the same scope of the instantly claimed invention, as such it is believed that suitable thickness, and the total "spaces", of the non-adhesive layer is also inherently disclosed.

Claim lacks novelty.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 49-30430 (English Abstract).

The teachings of JP '430 are again relied upon as set forth above.

For claim 2, it is noted that JP '430 lacks an express teaching of forming a colored substrate surface on the side next to the adhesive layer. However, it is believed to be common knowledge that the color density of a laminated structure increases as the adhesion improves, simply because the trapped air in a non-adhering area would scatter the light. Note also as evidence of the state of the art Beck et al. (US 4968658), which teaches that printing adhesion can be examined by comparing the colors with similar prints where no adhesion had occurred, differences in color balance were visible; and where portions of a dye coat had adhered, a solid block of one or more colors at high color density is obtained (column 4, lines 31-36). As such, it would have been obvious to one of ordinary skill in the art to include a colored layer on the substrate surface of JP '430, motivated by the desire to observe (through a transparent adherend) and confirm that an adequate adhesion of the reusable adhesive tape is maintained.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08-006229 (English Abstract) in view of JP 49-30430 (English Abstract).

The teachings of JP '430 are again relied upon as set forth above.

For claim 2, JP '229 is directed to a light shielding adhesive sheet. JP '229 teaches that the light shielding adhesive sheet consists of a light shielding sheet and a layer of an adhesive 4 formed on one side of the light shielding sheet. Further, the light shielding sheet is obtained by successively laminating a colored layer 2', an adhesive

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layer 3, a colored layer 2 and a transparent resin film 1 on a transparent resin film 1'. JP '430 lacks a teaching of a non-adhesive layer which partially covers the adhesive surface to permit repeated use of the light shielding adhesive sheet. However, it would have been obvious to one skilled in the adhesive art to combine the teachings of JP '229 and JP '430, motivated by the desire to be able to reuse the light shielding adhesive sheet.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
June 25, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

